REMARKS

The Application has been carefully reviewed in light of the Office Action mailed May 12, 2006. At the time of the Office Action, Claims 1-62 were pending in this patent application. Reconsideration and allowance of all pending claims is respectfully requested in view of the following remarks.

Examiner's Response to Arguments

The Examiner continues to rely on the improper reference of Wu in rejecting certain pending claims despite admitting that Wu is not an appropriate reference with respect to other claims by withdrawing previous objections. Moreover, the Examiner continues to ignore Applicants' remarks regarding this oversight.

Rejections Under 35 U.S.C. § 103:

The Examiner maintains rejections under 35 U.S.C. 103(a) as being anticipated over U.S. Pub. No. 2001/0048676 to Jimenez ("Jimenez") in view of U.S. Patent No. 6,199,076 to Logan ("Logan").

Claim 1

With regard to Claim 1, the Examiner admits that Jimenez does not disclose conversion of an advertisement into an audio format or an advertisement server. Nevertheless, the Examiner suggests that Logan's system for playing audio programming somehow teaches that such elements be used in combination with the elements of Jimenez.

As previously noted, the Examiner asserts that Logan discloses "means for forwarding the user requested Web content and advertisement to the text-to-speech transcoder for conversion to an audio format." However, the cited portions of Logan disclose only recognition of the fact that text can be converted into audio form [Column 6, lines 6 to 25], downloading web content generally [Column 6, lines 62 to 67], and determining the type and amount of advertisements based on content and cost parameters selected by a subscriber [Column 10, line 44 to Column 11, line 3; Column 11, lines 34 to 37]. Interestingly enough, while the text within these four disparate sections of Logan contain most of the words and phrases included in this element of

Claim 1, nothing in Logan ties the words and phrases together to suggest "means for forwarding the user requested Web content and advertisement to the text-to-speech transcoder for conversion to an audio format." In fact, the disparate portions of Logan employed by the Examiner itself suggests that those reviewing Logan at the time of its filing would not have come up with a suggestion of this element of Claim 1. The Examiner now attempts to assert that additional portions of Logan not previously cited by the Examiner somehow teach the aforementioned limitation. However, notably, none of the additional portions of Logan cited by the Examiner teach such an element. Column 6, lines 22 to 32 does not. Figure 1, items 130 and 135 does not. Column 6, lines 6-12 and 22-25 does not. The Examiner has still not cited a single portion of Logan that teaches the recited limitation. The Examiner also appears to be asserting that one of ordinary skill in the art "could reasonably infer from these teachings that Logan clearly indicates a means of converting web and advertising content from text form into audio form." Such inference is by no means clear. In fact, Logan discloses storing advertisements in audio, textual, and graphical form. See Column 6, lines 6-12. Such a statement would lead one of ordinary skill in the art to make an inference the opposite of the one suggested by the Examiner, namely that conversion of advertisements into an audio format is not intended since they are disclosed as stored as separate audio, textual, and graphical elements to form an advertisement for the player disclosed by Logan. Further, Logan teaches away from the delivery of any content in audio format, instead teaching that audio conversion be done after textual data has been received by the user device. See Column 6.

With regard to fulfilling the prima facie obligation of a suggestion to combine the teachings of Jimenez and Logan, the Examiner previously cited only an object of Logan [Column 1, line 66 to Column 2, line 3] that states that such object is to provide easy access to audio content "without the need of a visual display screen." Applicants stated that Applicants fail to see how such statement suggests the combination of Logan teachings with any of the teachings of Jimenez, much less all of those used to reject various elements of Claim 1. Instead, Applicants stated that Applicants believe the Examiner was using impermissible hindsight, both to combine separate portions of Logan that have appropriate key words in the wrong context, and to combine such portions of Logan with Jimenez to build a rejection of Claim 1 that does not consider the unique combination of elements recited therein. Now, the Examiner has withdrawn

the applicability of such teaching and apparently ceased any attempt to provide a teaching from either Logan or Jimenez to suggest the combination of references, relying instead solely on the fact that both reference concern text to audio conversions and that the combination would be desirable. As previously noted, such hindsight reconstruction is impermissible and the mere desirability of a combination does not establish the prerequisites for a prima facie rejection under 35 USC §103.

For at least these reasons, Applicants respectfully submit that the rejection of Claim 1 was improper and that the cited combination of Jimenez and Logan do not disclose, teach, or suggest the unique combination of references recited in Claim 1. As Claims 2 through 8 depend from Claim 1, Applicants respectfully submit that such claims are also allowable.

Further with regard to Claims 3 and 4, the portions of Logan cited by the Examiner having to do with scheduling, download time, and determining the amount of content a user would like to be presented have nothing to do with the "format and size" or "predetermined time length" of an advertisement. Nothing in Logan teaches either of the limitations cited by Claims 3 and 4.

Claim 9

With regard to Claim 9, the Examiner asserts that it has substantially the same limitations as Claim 1. Applicants, however, respectfully note that Claim 9 is substantially different from Claim 1. However, Applicants reiterate each of their remarks referencing the Examiner's rejection of Claim 1 and submit that the cited portions of Jimenez and Logan are even more inapplicable to the unique combination of elements recited by Claim 9.

The Examiner continues to assert that Logan discloses "means for notifying the advertisement server of user interaction with an advertisement" [Column 28, lines 6 to 65]. However, Logan's only tracking of advertisements disclosed is whether or not an advertisement has actually been played, and the start time, volume, and playing speed of an advertisement. None of these reflect any degree of user interaction with an advertisement.

For at least the foregoing reasons Applicants respectfully submit that Claim 9 is allowable over the cited combination of Jimenez and Logan. As Claims 10 through 19 depend from Claim 9, Applicants respectfully submit that Claims 10 through 19 are allowable as well.

Claims 20, 27, 39, and 46

With regard to Claims 20, 27, 39, and 46, the Examiner has still not provided any specific rejection of any of such independent claims. The Examiner merely states that they are similarly suggested for at least the reasons set forth for Claims 1 and 9. Applicants respectfully submit that Claims 20, 27, 39, and 46 are not identical to Claims 1 and 9 and that a prima facie case of obviousness has not been made with respect to any of such claims. Further, Applicants reiterate each of the remarks set forth above with respect to Claims 1 and 9. The stated combination of Jimenez and Logan does not disclose, teach, or suggest the unique combination of elements recited by Claims 20, 27, 39, and 46, and there is no express or implied suggestion to combine the teaching of Jimenez and Logan in the manner previous suggested by the Examiner. A statement that something can be accomplished without a visual display does nothing to suggest the unique combination of references recited by Claims 20, 27, 39, and 26. For at least these reasons, Applicants respectfully submit that Claims 20, 27, 39, and 46 are allowable over the recited prior art. As Claims 21-26, 28-38, 40-45, and 47-56 depend from Claims 20, 27, 39, and 46 respectively, Applicants respectfully submit that such claims are also allowable.

Claim 57

Applicant previously noted that Logan's disclosure of playback options on Column 27, line 41 to Column 28, line 5 does not disclose "means for receiving notification from a text-to-speech transcoder that the selected advertisement has been delivered to the user client in an audio format." The Examiner's only response is that Logan teaches text-to-audio conversion. Such a response does not indicate that Logan teaches the recited element of Claim 57.

The Examiner previously admitted that Logan does not disclose means for forwarding a selected advertisement to a Web server for insertion within the Web content requested by a user. The Examiner then asserted that Jimenez teaches such means by disclosing item 120. The Examiner has now also apparently withdrawn such assertion and now appears to be relying on the fact that "one of ordinary skill in the art" would desire to combine "server insertion functionality" and relieve client-side processing. The Examiner again presents no basis for such assertion other than mere desirability. Even if desirability were enough when the case law clearly indicates it is not, the Examiner is actually suggesting that one of ordinary skill in the art

would somehow be suggested to implement the system COUNTER to the client-side processing of Logan. THE PENULTIMATE TEACHING OF LOGAN IS THE USE OF THE CLIENT TO PERFORM FUNCTIONS PREVIOUSLY PERFORMED BY A SERVER PRIOR TO COMMUNICATION TO THE CLIENT. In fact, Claim 57 expressly recites that "the selected advertisement has been delivered to the user client device IN AN AUDIO FORMAT." Logan teaches AWAY from such a system and expressly states the disadvantages of such a system. Yet, the Examiner maintains that one of ordinary skill in the art should somehow proceed in an entirely opposite direction from Logan in picking and choosing certain disclosures of Logan and combining them to come up with a system Logan teaches against. Logan expressly states that any speech conversion be performed at the client because text uses less bandwidth. See Column 6, lines 22 through 37. Further, once again, no suggestion to combine the teachings of Jimenez and Logan is presented by the Examiner with regard to the elements of Claim 57.

The Applicant also reiterates the inappropriateness of the rejection of Claim 57 using the cited combination of Wu and Davis despite the unsuitability of Wu as a reference and the Examiner's use of mere desirability as the basis to combine the two references. The statement that advertisers need a more efficient system in Davis does not suggest the use of Wu, any system similar to Wu, or any element of Claim 57, much less such elements in combination.

For at least these reasons, Applicants respectfully submit that Claim 57 is allowable over the cited prior art. As Claims 58-62 depend from Claim 57, Applicants respectfully submit that such claims are also allowable.

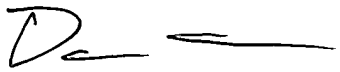
CONCLUSION

For the foregoing reasons, and for other apparent reasons, Applicants respectfully request reconsideration and favorable action. If the Examiner feels a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe that no fee is due, however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-2816 of Patton Boggs, L.L.P.

Respectfully submitted,

PATTON BOGGS, LLP



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